UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/314,958	05/20/1999	JUNICHI IIDA	P17948	5849

7055   7590   03/10/2004

GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191

EXAMINER
POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
2622	

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _11 December 2003_.
2a) ☐ This action is **FINAL**.　　　2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _19-24, 27-33 and 37-46_ is/are pending in the application.
　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) _19-24, 27-33 and 37-46_ is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
　　a) ☐ All　b) ☐ Some * c) ☐ None of:
　　　1. ☐ Certified copies of the priority documents have been received.
　　　2. ☐ Certified copies of the priority documents have been received in Application No. _____.
　　　3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
　　Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on 12/11/03 has been entered.

Response to Amendment

2.   Applicant's amendment was received on 12/11/03, and has been entered and made of

record. Currently, **claims 19-24, 27-33, and 37-46** are pending.

Response to Arguments

3.   Applicant's arguments with respect to **claims 19, 28, 37, and 38** have been considered

but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on
> sale in this country, more than one year prior to the date of application for patent in the United States.

5.   Claims 19, 20, 22-24, 28, 29, 31-33, and 37-46 are rejected under 35 U.S.C. 102(b) as

being anticipated by Saito *et al.* (EPO Patent Application Publication EP 0 835 011).

Regarding *claim 19*, Saito discloses a communication apparatus (see Figs. 1 and 2, netfax

1) connected to a terminal apparatus (reception terminal 3) via a network (network 2), with the

communication apparatus (netfax 1) comprising a control panel configured to at least enter a

destination address (panel section 15, column 6, lines 19 through 22), an e-mail transmitter that

performs an e-mail transmission to a destination in response to an input from the control panel

(column 6, lines 45 through 50), a file generator that generates a communication result file (log

file having access confirmation information, seen in Fig. 17) that includes a result of the e-mail

transmission communication performed by the e-mail transmitter (column 10, line 54 through

column 11, line 22, and column 12, line 42 through column 13, line 8, wherein access to the

message is a result of the e-mail communication), a memory that stores the communication result

file as a HTML file (see Figs. 16 and 17, column 10, line 54 through column 11, line 22), and a

communicator that transmits the communication result file to the terminal apparatus when a

request for the communication result file is received from the terminal apparatus (column 12,

line 42 through column 13, line 14), the communication result file being displayable at the

terminal apparatus (column 13, lines 4 through 14).

Regarding *claim 20*, Saito discloses the apparatus discussed above in claim 19, and

further teaches that the communication result file comprises a plurality of communication results

(see Fig. 17).

Regarding *claim 22*, Saito discloses the apparatus discussed above in claim 19, and

further teaches that the file generator generating a communication result as the HTML file to

update the communication result file in the memory when the e-mail transmitter performs an e-

mail transmission (see Figs. 9 and 18, column 8, lines 20 through 52, and column 11, lines 10

through 22).

Regarding *claim 23*, Saito discloses the apparatus discussed above in claim 19, and

further teaches that the memory stores a main file including a mark indicating a request for the

communication result file (column 11, lines 12 through 32, and column 12, line 30 through

column 13, line 8), and the communicator transmits the main file to the terminal apparatus in

response to actuation of the mark (column 12, line 56 through column 13, line 21).

Regarding *claim 24*, Saito discloses the apparatus discussed above in claim 23, and

further teaches that the request for the communication result file is performed by clicking the

mark on the main file at the terminal apparatus (column 12, line 42 through column 13, line 21).

Regarding *claim 28*, Saito discloses a method for checking a communication result of a

communication apparatus (see Figs. 1 and 2, netfax 1) connected to a terminal apparatus

(reception terminal 3) via a network (network 2), with the communication apparatus (netfax 1)

including a control panel (see Fig. 2, panel section 15), with the method comprising inputting a

destination address via the control panel (column 6, lines 19 through 22), performing an e-mail

transmission to a destination in response to an input from the control panel (column 6, lines 45

through 50), generating a communication result file (log file having access confirmation

information, seen in Fig. 17) including a result of the e-mail transmission communication

performed (column 10, line 54 through column 11, line 22, and column 12, line 42 through

column 13, line 8, wherein access to the message is a result of the e-mail communication),

storing the communication result file as a HTML file in a memory (see Figs. 16 and 17, column

10, line 54 through column 11, line 22), and transmitting the communication result file to the

terminal apparatus when a request for the communication result file is received from the terminal

apparatus (column 12, line 42 through column 13, line 14), the communication result file being

displayable at the terminal apparatus (column 13, lines 4 through 14).

Regarding *claim 29*, Saito discloses the method discussed above in claim 28, and further

teaches that the communication result file comprises a plurality of communication results (see

Fig. 17).

Regarding *claim 31*, Saito discloses the method discussed above in claim 28, and further

teaches of generating a communication result as the HTML file to update the communication

result file in the memory when e-mail transmission is performed (see Figs. 9 and 18, column 8,

lines 20 through 52, and column 11, lines 10 through 22).

Regarding *claim 32*, Saito discloses the method discussed above in claim 28, and further

teaches of transmitting a main file, including a mark indicating a request for the communication

result file (column 11, lines 12 through 32, and column 12, line 30 through column 13, line 8), to

the terminal apparatus before transmitting the communication result file (column 12, line 56

through column 13, line 21).

Regarding *claim 33*, Saito discloses the method discussed above in claim 32, and further

teaches that the request for the communication result file is performed by clicking the mark on

the main file at the terminal apparatus (column 12, line 42 through column 13, line 21).

Regarding *claim 37*, Saito discloses a communication apparatus (see Figs. 1 and 2, netfax

1) connected to a terminal apparatus (reception terminal 3) via a network (network 2), with the

communication apparatus (netfax 1) comprising a control panel configured to input a destination

address (panel section 15, column 6, lines 19 through 22), an e-mail transmitter that performs an

e-mail transmission to a destination in response to an input from the control panel (column 6,

lines 45 through 50), a facsimile transmitter that performs a facsimile transmission to a

destination via a telephone network (column 6, lines 5 through 8), a file generator that generates

a communication result file (log file having access confirmation information, seen in Fig. 17)

that includes a result of the e-mail transmission communication performed by the e-mail

transmitter (column 10, line 54 through column 11, line 22, and column 12, line 42 through

column 13, line 8, wherein access to the message is a result of the e-mail communication), a

determiner that determines whether to perform an e-mail transmission to the destination by the e-

mail transmitter or to perform a facsimile transmission to the destination by the facsimile

transmitter (CPU 11, column 6, lines 1 through 28, and column 8, lines 29 through 44, whereby

an e-mail transmission would be performed when an e-mail address is input via the panel section

15, or a facsimile transmission would be performed through the public telecommunication

network when a telephone number is input via the panel section 15), a memory that stores the

communication result file as a HTML file (see Figs. 16 and 17, column 10, line 54 through

column 11, line 22), and a communicator that transmits the communication result file to the

terminal apparatus when a request for the communication result file is received from the terminal apparatus (column 12, line 42 through column 13, line 14), the communication result file being displayable at the terminal apparatus (column 13, lines 4 through 14).

Regarding *claim 38*, Saito discloses a method for checking a communication result of a communication apparatus (see Figs. 1 and 2, netfax 1) connected to a terminal apparatus (reception terminal 3) via a network (network 2), with the communication apparatus (netfax 1) including a control panel (see Fig. 2, panel section 15), with the method comprising inputting a destination address via the control panel (column 6, lines 19 through 22), performing an e-mail transmission to a destination in response to an input from the control panel (column 6, lines 45 through 50), performing a facsimile transmission to a destination via a telephone network (column 6, lines 5 through 8), determining whether to perform the e-mail transmission to the destination or to perform a facsimile transmission to the destination (column 6, lines 1 through 28, and column 8, lines 29 through 44, whereby an e-mail transmission would be performed when an e-mail address is input via the panel section 15, or a facsimile transmission would be performed through the public telecommunication network when a telephone number is input via the panel section 15), generating a communication result file (log file having access confirmation information, seen in Fig. 17) including a result of the e-mail transmission communication performed (column 10, line 54 through column 11, line 22, and column 12, line 42 through column 13, line 8, wherein access to the message is a result of the e-mail communication), storing the communication result file as an HTML file (see Figs. 16 and 17, column 10, line 54 through column 11, line 22), and transmitting the communication result file to the terminal apparatus when a request for the communication result file is received from the terminal

apparatus (column 12, line 42 through column 13, line 14), the communication result file being displayable at the terminal apparatus (column 13, lines 4 through 14).

Regarding *claim 39*, Saito discloses the apparatus discussed above in claim 19, and further teaches of an input device configured to input image data to the communication apparatus (scanner section 16, see Fig. 2, column 5, line 38 through column 6, line 28), the input device connected to the communication apparatus independently of the network (see Fig. 2, column 6, lines 22 through 28).

Regarding *claim 40*, Saito discloses the apparatus discussed above in claim 39, and further teaches that the input device comprises a scanner (scanner section 16, see Fig. 2, column 5, line 38 through column 6, line 28).

Regarding *claim 41*, Saito discloses the method discussed above in claim 28, and further teaches of inputting image data to the communication apparatus by an input device (scanner section 16, see Fig. 2, column 5, line 38 through column 6, line 28) connected to the communication apparatus independently of the network (see Fig. 2, column 6, lines 22 through 28).

Regarding *claim 42*, Saito discloses the method discussed above in claim 41, and further teaches that the inputting comprises a scanning (through scanner section 16, see Fig. 2, column 5, line 38 through column 6, line 28).

Regarding *claim 43*, Saito discloses the apparatus discussed above in claim 37, and further teaches of an input device configured to input image data to the communication apparatus (scanner section 16, see Fig. 2, column 5, line 38 through column 6, line 28), the input device

connected to the communication apparatus independently of the network (see Fig. 2, column 6, lines 22 through 28).

Regarding *claim 44*, Saito discloses the apparatus discussed above in claim 43, and further teaches that the input device comprises a scanner (scanner section 16, see Fig. 2, column 5, line 38 through column 6, line 28).

Regarding *claim 45*, Saito discloses the method discussed above in claim 38, and further teaches of inputting image data to the communication apparatus via an input device (scanner section 16, see Fig. 2, column 5, line 38 through column 6, line 28) connected to the communication apparatus independently of the network and of the telephone network (see Fig. 2, column 6, lines 22 through 28).

Regarding *claim 46*, Saito discloses the method discussed above in claim 45, and further teaches that the inputting comprises a scanning (through scanner section 16, see Fig. 2, column 5, line 38 through column 6, line 28).

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

7.   **Claims 21, 27, and 30** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Saito *et al.* (EPO Patent Application Publication EP 0 835 011) in view of Smith *et al.* (U.S.

Patent Number 6,385,655, cited in the Office action dated 8/13/03).

Regarding ***claims 21 and 30***, Saito discloses the apparatus and method discussed above

in claims 19 and 28, respectively, but fails to particularly teach if the communication result file

comprises at least one of a communication date and a destination associated with a

communication result. Smith discloses a communication apparatus (see Fig. 1, server 22)

connected to a terminal apparatus (sending computer 14) via a network (electronic network 18),

with the communication apparatus (server 22) comprising an e-mail transmitter that performs an

e-mail transmission to a destination (column 5, lines 48 through 61), a file generator that

generates a communication result file (see Figs. 10-13, column 13, lines 16 through 31, and

column 14, line 35 through column 15, line 32) that includes a result of the e-mail transmission

communication performed by the e-mail transmitter (see Figs. 11-13, column 14, line 48 through

column 15, line 6), a memory that stores the communication result file as a HTML file (column

2, line 44 through column 3, line 44, and column 10, lines 45 through 59), and a communicator

that transmits the communication result file to the terminal apparatus when a request for the

communication result file is received from the terminal apparatus (see Fig. 10, column 13, line

15 through column 14, line 41), the communication result file being displayable at the terminal

apparatus (see Figs. 1, and 10-13). Further, Smith teaches that the communication result file

comprises at least one of a communication date and a destination associated with a

communication result (see Figs. 11-13). Because both Smith and Saito teach of the

communication apparatus acting as a server (see Smith: column 5, lines 32 through 55, being

server 22; and see Saito: column 7, lines 41 through 56, being netfax 1, with server mechanism

25), it would have been obvious to a person of ordinary skill in the art at the time the invention

was made to include the teachings of Smith in the system of Saito. Saito's system would easily

be modified to include Smith's teachings, as both systems share cumulative features, being

additive in nature.

Regarding *claim 27*, Saito discloses the apparatus discussed above in claim 37, but fails

to specifically teach if the communication result file comprises at least one of a communication

date, a destination, a number of sheets, a communication duration time and a charge, associated

with a communication result. Smith discloses a communication apparatus (see Fig. 1, server 22)

connected to a terminal apparatus (sending computer 14) via a network (electronic network 18),

the communication apparatus (server 22) comprising an e-mail transmitter that performs an e-

mail transmission to a destination (column 5, lines 48 through 61), a facsimile transmitter that

performs a facsimile transmission to a destination via a telephone network (column 5, lines 48

through 61), a file generator that generates a communication result file (see Figs. 10-13, column

13, lines 16 through 31, and column 14, line 35 through column 15, line 32) that includes a result

of the e-mail transmission communication performed by the e-mail transmitter (see Figs. 11-13,

column 14, line 48 through column 15, line 6), a determiner that determines whether to perform

an e-mail transmission to the destination by the e-mail transmitter or to perform a facsimile

transmission to the destination by the facsimile transmitter (column 5, lines 56 through 61,

column 7, lines 60 through 67, and column 8, line 66 through column 9, line 15), a memory that

stores the communication result file as a HTML file (column 2, line 44 through column 3, line

44, and column 10, lines 45 through 59), and a communicator that transmits the communication

result file to the terminal apparatus when a request for the communication result file is received

from the terminal apparatus (see Fig. 10, column 13, line 15 through column 14, line 41), the

communication result file being displayable at the terminal apparatus (see Figs. 1, and 10-13).

Further, Smith teaches that the communication result file comprises at least one of a

communication date, a destination, a number of sheets, a communication duration time and a

charge, associated with a communication result (Figs. 11-13). Because both Smith and Saito

teach of the communication apparatus acting as a server (see Smith: column 5, lines 32 through

55, being server 22; and see Saito: column 7, lines 41 through 56, being netfax 1, with server

mechanism 25), it would have been obvious to a person of ordinary skill in the art at the time the

invention was made to include the teachings of Smith in the system of Saito. Saito's system

would easily be modified to include Smith's teachings, as both systems share cumulative

features, being additive in nature.

Citation of Pertinent Prior Art

8.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure:

Mochizuki (U.S. Patent Number 6,101,526) discloses an apparatus that scans and

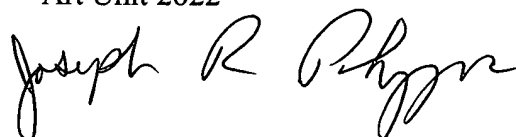transmits image data as e-mail having HTML text.

Conclusion

9.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The

examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa
Examiner
Art Unit 2622

jrp